

## **REMARKS/ARGUMENTS**

### Election of Inventions

The Examiner has requested an election of a single invention for prosecution on the merits. The Examiner has identified the following groups of inventions:

- Group I        Claims 1-3 drawn to a method of treating a patient;
- Group II       Claims 4, and 7-18, drawn to a pharmaceutical formulation;
- Group III      Claims 19-23, drawn to an implant.

The Examiner's position is that the inventions do not relate to a single general inventive concept under PCT Rule 13.1 because they lack the same or corresponding special technical features. The Examiner maintains that the special technical feature common to all groups, a formulation containing yttrium, neodymium or zirconium, can not be considered a patentable advance over the prior art.

The Examiner also requires election of a single species for immediate prosecution. The Examiner maintains that the species do not form a single inventive concept under PCT Rule 13.1. The alleged species identified are pharmaceutical formulations containing: A) yttrium, B) neodymium, C) zirconium, D) yttrium, neodymium and zirconium, and where the carrier is: E) an alloy, or F) a bioresorbable polymer.

The Applicants traverse the restriction requirement because Examiner is required to establish that a serious burden would be placed on the Examiner if the restriction requirement was not made. (MPEP 802.02) The Examiner has failed to do so.

The Applicants also traverse the restriction/election requirement and request reconsideration of the species election requirement on the grounds that the species identified by the Examiner are not mutually exclusive. "Where two or more species are claimed, a requirement for restriction to a single species may be proper if the species are mutually exclusive. Claims to different species are mutually exclusive if one claim recites limitations disclosed for a first species but not a second, while a second claim recites

limitations disclosed only for the second species but not the first. This may also be expressed by saying that to require restriction between claims limited to species, the claims must not overlap in scope.” (MPEP 806.04(f).) The species as identified by the Examiner, clearly overlap. First, the claims in group II are “comprising” claims. Therefore, even formulations that contain yttrium according to these claims may also include additional components such as neodymium, zirconium, or both. Claims directed to formulations containing yttrium may also have dependent from claims which recite the additional inclusion of neodymium and/or zirconium.

The overlap between the identified species can be particularly seen in claim 12. While claim 12 only specifically recites the presence of yttrium, it additionally recites the presence of rare earth elements other than yttrium. One such element is neodymium. Therefore, a formulation satisfying the elements of claim 12 can either read on or not read on multiple species, depending on which rare earth elements are present, as recited in that claim. Thus, it is clear that the species identified by the Examiner are not mutually exclusive.

Similarly, the species of an alloy and a bioresorbable polymer are not separate species, but are different embodiments of a biodegradable carrier, as recited in claim 4.

While the Applicants traverse the restriction requirement, Applicants recognize the requirement to elect an invention for prosecution, and elect the claims of Group II and the species of yttrium (Species A) and an alloy as the carrier (Species E). Claims 7, 9, 12, and 15 are believed to read upon the elected group and species.

The outstanding Office Action was electronically transmitted on 20 December 2007. The Examiner set a shortened statutory period for reply of 1 month from the mailing date. Therefore, no extension of time or accompanying fee is believed to be due in making this response, as 20 January 2008 fell on a Sunday and 21 January 2008 was a federal holiday. Nevertheless, the Applicants hereby make a conditional petition for an extension of time for response in the event that such a petition is required. No claims

have been cancelled or added. Therefore, no additional fees are believed to be due. However, in the event that a fee for the filing of his response is insufficient, the Commissioner is authorized to charge any fee deficiency or to credit any overpayment to Deposit Account 15-0450.

Respectfully submitted,

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